

THIS DISPOSITION IS NOT
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JUNE 30, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re GoldenCare Corporation

Serial No. 74/349,470

H. Robert Henderson, Richard L. Fix and Michael O. Strum of
Henderson and Strum for GoldenCare Corporation.

Darlene D. Bullock, Trademark Examining Attorney, Law Office 101
(R. Ellsworth Williams, Managing Attorney).

Before Simms, Seeherman and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

GoldenCare Corporation has filed an application to
register the mark "GOLDENCARE PROTECTOR" for services which by a
"supplemental" amendment were ultimately identified as "providing
services to the life and health insurance industry; namely,
conducting business and market research surveys for the
development and marketing of life and health insurance products
and annuities."¹

¹ Ser. No. 74/349,470, filed on January 19, 1993, based upon an
allegation of a bona fide intention to use the mark in commerce. As
originally filed, the application cryptically identified the services
as "providing services to the health care insurance industry: namely,

Following publication of the mark for such services on March 8, 1994 and issuance of a notice of allowance therefor on May 31, 1994, applicant submitted, along with the required fee, a timely statement of use on November 21, 1994 which alleges dates of first use for the services identified in the notice of allowance of November 1, 1993. The specimens accompanying the statement of use, however, are advertising brochures or booklets which show use of the mark "GOLDENCARE PROTECTOR" in connection with "LONG-TERM CARE INSURANCE" policies which include "Nursing Home and Optional Home Health & Community Care Benefits".² Because "[t]he specimens do not show use of the mark for any services identified in the application," the Examining Attorney issued an Office action on February 6, 1995 requiring that

in developing and marketing health care insurance products". Such identification, prior to being further amended as set forth above, was subsequently modified, along the lines suggested by the Examining Attorney in her first Office action, to read: "providing services to the health care insurance industry, namely conducting business and market research surveys for the development and marketing of health care insurance products". We note, however, that although the supplemental amendment of applicant's services, as set forth above, is *broader*--by virtue of the inclusion of both the *life* insurance industry and *life* insurance products and the deletion of the word "care"--than either the original or modified identifications, no objection thereto was ever raised by the Examining Attorney.

² Among other things, the brochures state that (**emphasis added**):

This booklet provides only a brief outline of the major provisions of the GOLDENCARE PROTECTOR **long-term care health insurance program**. Your GOLDENCARE PROTECTOR **Policy** ... and its riders, if any, will describe your coverage in detail and will be used in **determining your coverage and eligibility for benefits**. The benefits provided, the premium, and the form number **will depend on the Policy selected and issued**.

"applicant ... submit three specimens showing use of the mark for the services specified."³

Applicant, in a timely response, submitted a set of substitute specimens on August 4, 1995. Applicant's submission includes a declaration, pursuant to Trademark Rules 2.20 and 2.59(b), "verifying that the substitute specimens were in use in commerce at least as early as the expiration of the time allowed to Applicant for filing a statement of use." The set of substitute specimens, however, consists in part of advertising brochures or booklets which, like those filed with the statement of use, show use of the mark "GOLDENCARE PROTECTOR" for "LONG-TERM CARE INSURANCE" policies which include "Nursing Home and Optional Home Health & Community Care Benefits".⁴ The substitute specimens also include copies of a letter dated July 26, 1995 which accompanied such literature. The letter, which contains the salutation "Dear Agent" and is typed on stationery bearing

³ The Examining Attorney, in connection therewith, also required that applicant "verify, with an affidavit or declaration, ... that the substitute specimens were in use in commerce **at least as early as the filing date of the application**" (**emphasis added**), citing Trademark Rule "2.59(a)". It is pointed out, however, that the applicable rule is Trademark Rule 2.59(b), which provides in relevant part that, after filing a statement of use, "the applicant may submit substitute specimens of the mark as used ... in the sale or advertising of the services, provided that the use in commerce of any substitute specimens submitted is supported by applicant's affidavit or declaration ... verify[ing] that the substitute specimens were in use in commerce prior to filing of the statement of use or prior to the expiration of the time allowed to applicant for filing a statement of use."

⁴ Like the specimens submitted with the statement of use, the brochures include the same language as that previously quoted in footnote 2 of this opinion.

the letterhead "GOLDENCARE," reads in pertinent part as follows

(**emphasis added**):

In order to provide better service to agents in the life and health insurance industry, we are **conducting a business and market research survey** to help develop and market life and health insurance products and annuities.

We ask that you review **the enclosed brochure which describes such products, entitled GOLDENCARE PROTECTOR.** (This particular brochure was prepared by us for use in Massachusetts.) We will be contacting you to ascertain whether the material as presented is easy for a consumer to understand--and, of course, its usefulness as a sales tool for the agent.

In view thereof, and inasmuch as any substitute specimens had to have been in use in commerce by no later than November 30, 1994 (which is the date of expiration of the six-month period provided by the May 31, 1994 notice of allowance), the Examining Attorney issued a final refusal on September 5, 1995 in which she indicated, among other things, that (**emphasis in original**):

The examining attorney has carefully considered the [set of substitute] specimens but they remain unacceptable for the following reasons. First, the substitute specimens do not appear to have been in use before the expiration period for filing the Statement of Use. The date shown on the "letter" part of the substitute specimens list [sic] the date as July 25 [sic], 1995. Secondly, the new specimens still do not show use of the mark [in connection] with the services identified in the notice of allowance. **Consequently, the examining attorneys [sic] refusal regarding the specimens is maintained and made FINAL.**

Applicant, in a timely response submitted with a certificate of mailing dated March 5, 1996, filed an amendment to change the identification of its services to "providing services to the life and health insurance industry; namely, conducting business for the development and marketing of life and health insurance products and annuities".⁵ As justification for such amendment, which differs in substance from the identification of services set forth in the notice of allowance by deleting the reference in the latter to both the word "care" and the language "and market research surveys," applicant asserts that:

We have an allowable mark and a Statement of Use submitting appropriate specimens showing use as early as September 1993; although Applicant claims only a date of first use of November 1, 1993. It remains only, therefore, for Applicant and the U.S. Patent and Trademark Office to agree on an identification of those services based upon the specimens submitted with the Statement of Use.

Applicant, after acknowledging a telephone conference with the Examining Attorney on March 4, 1996, further contends that:

The Statement of Use specimens show that as of September 1993, Applicant had done business with ... Bankers United Life Assurance Company of Cedar Rapids, Iowa, in developing a long-term health insurance program involving a Golden Care Protector

⁵ With respect to an amendment to the identification of goods or services set forth in a statement of use, Trademark Rule 2.88(f) provides in relevant part that "[t]he statement of use may be amended in accordance with §§ 2.59 and 2.71 through 2.75." Trademark Rule 2.71(b), in particular, specifies that "[t]he identification of goods or services may be amended to clarify or limit the identification, but additions will not be permitted."

Policy for individuals, underwritten by said Bankers United Life Assurance Company.

In this instance, Applicant worked with Bankers United Life in developing the certain type of policy, and provided the brochure submitted as the specimens to be utilized for marketing the program.

During the prosecution of this intent-to-use application, the notice of allowance included the term ... "market research surveys" [--] a term [previously] recommended by the Trademark Examining Attorney Applicant admittedly was [subsequently] unable to submit specimens showing such use prior to [its claimed dates of first use of] November 1, 1993, and thus respectfully submits [that] its identification of services should be limited to what its specimens do support.

....

It is respectfully submitted that the specimens of record do show use of the mark for the services now identified.

The Examining Attorney, in reply, issued an Office action on April 29, 1996 stating that "[t]he Final refusal to accept the specimens is maintained." The Examining Attorney additionally noted, moreover, that:

The applicant has [submitted an] amendment [to] the recitation of services. However, said recitation is unacceptable because it is beyond the scope of the services as listed in the notice of allowance. Therefore, the applicant may not amend [the application] to include any services that are not within the scope of the services recited in the present identification.

In a timely response thereto, applicant on July 29, 1996 submitted a further amendment to change the identification of its services to "providing services to the life and health care insurance industry; namely, in developing and marketing

health care insurance products for others". Applicant insists that such amendment is justified by the set of substitute specimens which it filed on August 4, 1995 and that, despite the July 26, 1995 date appearing on some of the specimens, "those specimens do show use in commerce at least as early as the expiration of time allowed to Applicant for filing the Statement of Use". Applicant also urges that "the amended recitation of services are not 'beyond the scope of the services listed in the Notice of Allowance' because the amended services are actually less or of a diminished nature than those set forth in the Notice of Allowance of May 31, 1994."

In reply, the Examining Attorney on September 11, 1996 issued an Office action which "maintained and made Final" the requirement for "acceptable specimens showing use of the mark for the proposed services." The Examining Attorney also "maintained and made Final" the refusal on the ground that applicant's "amendment to the recitation of services ... is unacceptable because it is beyond the scope of the goods [sic] listed in the notice of allowance."

Applicant has appealed. Briefs have been filed, but an oral hearing was not held.⁶ We affirm both the refusal that the identification of services exceeds the scope of the services specified in the notice of allowance and the requirement for specimens showing use of the mark for the services set forth in the notice of allowance.

⁶ Although applicant timely filed a request for an oral hearing, it subsequently withdrew such request.

Applicant, in its initial brief, notes that, in the response which it filed with a certificate of mailing dated March 5, 1996, it "admitted that its specimens could not meet the 'market research surveys' portion of the identification of services in the Notice of Allowance." Applicant argues, however, that amending its services from "providing services to the life and health insurance industry; namely, conducting business and market research surveys for the development and marketing of life and health insurance products and annuities," as identified in the notice of allowance, to "providing services to the life and health insurance industry; namely, conducting business for the development and marketing of life and health insurance products and annuities," as set forth in its amendment of March 5, 1996, is within the scope of the services listed in the notice of allowance. Specifically, applicant maintains that such amendment simply "attempted to limit the identification of services as per the specimens of record submitted with the Statement of Use." Although applicant's initial brief is silent with respect to the fact that, on July 29, 1996, it further amended its services to "providing services to the life and health care insurance industry; namely, in developing and marketing health care insurance products for others," applicant argues in its reply brief such amendment likewise is merely a limitation designed to reflect the services evidenced by, presumably, the specimens filed with the statement of use.⁷

⁷ It would appear from applicant's reply brief that applicant is no longer relying upon the set of substitute specimens which it

In any event, applicant insists in its reply brief that:

There is no doubt that Applicant clearly has attempted to limit the identification of services. That identification at the time of the Notice of Allowance included both ... (1) conducting of business for the development and marketing of life and health insurance products and annuities; and (2) conducting market [research] surveys for the development and marketing of life and health insurance products and annuities. By deleting the services of "conducting market [research] surveys for the development and marketing of life and health insurance products and annuities," it is respectfully submitted that Applicant clearly has given up the scope of protection of its mark as to that feature of its services.

Applicant accordingly maintains, as set forth in its reply brief, that "the Amendment to the recitation of services is not beyond the scope of services listed in the Notice of Allowance."

The Examining Attorney, on the other hand, contends that "the applicant's amendment to the recitation of services is

submitted, under a declaration from its president, on August 5, 1995. Specifically, applicant states in its reply brief that it "wishes to point out that Applicant's Brochure specimen filed previously herein, under Declaration by Applicant's President, shows that as of September 1993, prior to the filing ... of the Statement of Use on November 21, 1994, Applicant's specimens indicate and prove up the provision of services to the life and health insurance industry; namely, the conducting of business for development and marketing of life and health insurance products and annuities." Notwithstanding that applicant further amended the identification of its services to read as indicated above, the only group of specimens which arguably fit the quoted description thereof in applicant's reply brief are the brochures or booklets furnished with applicant's verified statement of use. Although, as previously mentioned, applicant also submitted, with an accompanying declaration from its president, a set of substitute specimens on August 5, 1995 which included brochures or booklets which are identical in substance to those it submitted with its statement of use, the substitute brochures or booklets bear a date of March 1995 (written as "3/95") and thus, unlike those filed with the statement of use, which show a September 1993 date (listed as "9/93"), could not have been in use in commerce prior to November 30, 1994, as sworn to by applicant's president.

beyond the scope of the services listed in the Notice of Allowance." Moreover, the Examining Attorney states, with respect to the requirement for specimens showing use of the mark for the services identified, that inasmuch as "applicant has admitted that the specimens submitted did not support [any of] the services listed in the notice of allowance ..., this issue is moot and is not addressed in this brief."⁸

Citing an accompanying definition of the word "survey" from the "Random House Dictionary," which among other things defines such term as a verb meaning "3. to conduct a survey of or among: *to survey TV viewers*" and as a noun signifying "9. a sampling or partial collection, of facts, figures, or opinions taken and used to approximate or indicate what a complete collection and analysis might reveal: *The survey showed the percentage of the population that planned to vote,*"⁹ the

⁸ We do not take such statement, however, as a withdrawal of the requirement. Although, in particular, the word "moot" is problematic, we construe the Examining Attorney's statement to mean that, irrespective of whether applicant's amended identification of services is beyond the scope of the services set forth in the notice of allowance, none of applicant's specimens is acceptable, since they do not evidence use of the mark "GOLDENCARE PROTECTOR" for any of the services identified in the notice of allowance, and thus the requirement is proper. However, as to applicant's asserted "admission," we note that such applies only to its concession that the specimens which it has furnished do not evidence use of the mark "GOLDENCARE PROTECTOR" for the services of providing market research surveys. Applicant plainly maintains, at least with respect to the specimens furnished with its statement of use, that such specimens demonstrate use of the mark "GOLDENCARE PROTECTOR" for the services described in the amendments to its identification of services.

⁹ The Examining Attorney's request that we take judicial notice thereof is approved inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. *See, e.g.,* *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953) and *University of Notre Dame du Lac v. J. C. Gourmet*

Examining Attorney argues in her brief that, as amended, applicant's identification of services is outside of the scope of the services set forth in the notice of allowance. Specifically, noting that the notice of allowance lists "providing services to the life and health insurance industry; namely, conducting business and market research surveys for the development and marketing of life and health insurance products and annuities" as the identification of applicant's services, the Examining Attorney argues that (**emphasis in original**):

It is clear from the above recitation of services that the services provided by applicant consist of conducting business and market surveys. The applicant's recitation of services is further narrowed by the wording "for the development and marketing of life and health insurance products and annuities." The ordinary meaning of these services is conducting marketing surveys regarding life and health insurance products and annuities.

The applicant has attempted to amend its recitation of services to "**providing services to the life and health [care] insurance industry; namely, [in] developing and marketing health care insurance products for others ...**" The applicant erroneously believes that because the wording "marketing" remains in the recitation of services that the applicant has "limited" the recitation of services. However, the examining attorney contends that the applicant has broadened the recitation of services. The applicant has basically gone from "conducting business and marketing surveys" to "developing and marketing health care insurance products." Developing and marketing health care insurance products is a very broad description of services that goes beyond conducting surveys. Therefore, the applicant's proposed amendment does not

constitute a limitation of the recitation of services. Consequently, the applicant's proposed recitation of services is beyond the scope of the services listed in the Notice of Allowance and is[,] therefore, not acceptable.

Trademark Rule 2.88(i)(1) requires that "[t]he goods or services specified in a statement of use must conform to those goods or services identified in the notice of allowance." While, as noted previously (see footnote 5), Trademark Rule 2.71(b), as made applicable by Trademark Rule 2.88(f), provides that the identification of services may be amended to clarify or limit the identification, additions thereto are not permitted. Here, the amendments subsequently made by applicant plainly list services different from those stated in the notice of allowance. Such amendments consequently constitute additions to, and thus exceed the scope of, the services set forth in the notice of allowance, which identifies applicant's services as "providing services to the life and health insurance industry; namely, conducting business and market research surveys for the development and marketing of life and health insurance products and annuities." In either event, it is clear that the amendment of the statement of use to identify such services as "providing services to the life and health insurance industry; namely, conducting business for the development and marketing of life and health insurance products and annuities" and the further amendment to identify applicant's services as "providing services to the life and health care insurance industry; namely, in developing and marketing health care insurance products for others" fail to take

into account that the crux of the services recited in the notice of allowance is the conducting of business surveys and the conducting of market research surveys, which in each instance are conducted for purposes of the development and marketing of life and health insurance products and annuities. That such is the ordinary and reasonable construction of the services identified in the notice of allowance is made clear, for example, by applicant's set of substitute specimens, which show, in the case of the July 26, 1995 letter accompanying a copy of its brochure, that applicant is "conducting a business and market research survey to help develop and market life and health insurance products and annuities." By thus deleting reference, in its amendments, to conducting business and market research surveys from the services identified in the statement of use, applicant has added different services and, thus, has broadened its identification of services beyond the scope of those set forth in the notice of allowance.

Moreover, even if we were to agree with applicant that the amended identifications of its services are included within the services set forth in the notice of allowance and thus the amendments were permissible, the fact remains that none of the specimens furnished demonstrates use of the mark "GOLDENCARE PROTECTOR" for the services recited. Section 1(d)(1) of the Trademark Act, 15 U.S.C. §1051(d)(1), provides in relevant part that an applicant, as part of the submission of a statement of use, shall "submit specimens or facsimiles of the mark as used in commerce". In view thereof, Trademark Rule 2.88(b)(2)

specifically requires that "[a] complete statement of use must include . . . [t]hree specimens or facsimiles . . . of the mark as used in commerce."

We agree with the Examining Attorney that additional, properly verified specimens are necessary inasmuch as the brochures or booklets submitted as specimens with the statement of use, although in use in commerce prior to November 30, 1994, evidence use of the service mark "GOLDENCARE PROTECTOR" to identify and distinguish only a health care insurance policy which has certain features and benefits rather than the services of developing and marketing of health insurance products for others. Likewise, the brochures or booklets submitted as part of applicant's set of substitute specimens demonstrate use, as of March 1995, of the mark "GOLDENCARE PROTECTOR" only in connection with health care insurance services consisting of an insurance policy with various enumerated benefits and features and simply do not show use thereof for the services of developing and marketing health insurance products for others. Although, as indicated earlier, the substitute specimens also include copies of a letter dated July 26, 1995 which accompanied such advertising literature, such letter utilizes only the term "GOLDENCARE" in reference to applicant's conducting of a business and market research survey of insurance agents to help develop and market life and health insurance products and annuities. The service mark "GOLDENCARE PROTECTOR," as the letter makes clear, is used to identify and distinguish the actual health insurance services available under such a policy, as is shown by the

reference in the letter to "the enclosed brochure which describes such products, entitled GOLDENCARE PROTECTOR." Furthermore, and in any event, applicant has never offered any explanation as to the glaring discrepancy between its president's verification that the substitute specimens were in use in commerce as of no later than the November 30, 1994 deadline for filing the statement of use and the subsequent dates of March 1995 and July 26, 1995 respectively shown on the face of the advertising brochure or booklet and the business and marketing survey letter sent to insurance agents.

Simply stated, therefore, since none of the specimens furnished by applicant establishes use of the mark "GOLDENCARE PROTECTOR" for the identified services, as amended, set forth in the statement of use, the requirement for "acceptable specimens" showing use of such mark for the services identified is proper.

Decision: The refusal on the ground that applicant's amendment of the identification of its services is unacceptable because it is beyond the scope of the services listed in the notice of allowance and the requirement for "acceptable specimens showing use of the mark for the proposed services" are affirmed.

R. L. Simms

E. J. Seeherman

G. D. Hohein

Ser. No. 74/319,375

Administrative Trademark Judges,
Trademark Trial and Appeal Board